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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,920	03/16/2001	Steven P. Bitler	12969-1	7133

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EXAMINER
SZEKELY, PETER A

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 03/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-18

Office Action Summary	Application No. 09/810,920	Applicant(s) BITLER ET AL.	
	Examiner Peter Szekely	Art Unit 1714	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 February 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 9-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 9-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☒ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *17* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

1. The amendment filed 02/03/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In the paragraph replacing the paragraph from page 10, line 14, to page 10, line 18 the new matter is the "at least 2%" and "at least 0.5%", before the "e.g."-s. P.3 10/8/03

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21-25, 31, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 21-25, 39 and 40 contain the phrase "at least 2%". The phrase does not occur in the original specification. Claim 31 contains the phrase "a least 0.5%". The phrase does not occur in the original specification.

4. Claims 21-25, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for 2-10% by weight concentration

range of the SCCP, does not reasonably provide enablement for 2-100% by weight concentration range of the SCCP. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. See page 10, line 14-18 of the original specification.

5. Claim 31 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a 0.5-5% by weight concentration range of the SCCP, does not reasonably provide enablement for a 0.5-100% by weight concentration range of the SCCP. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. See page 10, line 14, of the original specification.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-7 and 9-61 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-73 of copending Application No. 09/398,377. Although the conflicting claims are not identical, they are not patentably distinct from each other because they cover the same subject matter featuring identical compositions and overlapping concentrations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-7, 9-12, 20, 37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al. 5,281,329 with Morawsky et al. 5,736,125 as a teaching reference.

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-6, 9-12, 20, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al. 5,281,329 in view of Morawski et al. 5,736,125.

Response to Arguments

12. Applicant's arguments filed 02/03/03 have been fully considered but they are not persuasive. At least 2% and at lest 0.5% are not in the original specification, therefore they are new matter. "At least" means "not less than" which is a negative limitation

necessitating explicit antecedent basis. Ex parte Grasselli, 231 USPQ393-394 (PTOBOAI 1983). The claims have no upper concentration limits; therefore they include concentrations, which are not described in the specification or in the Examples. What is the level at which the oil becomes unworkable because of very high viscosity is unknown and finding it involves undue experimentation. Mr. Steinberg's opinion is exactly that, e.g. an opinion. He does not say why he could envision an SCCP concentration of over 10% by weight or that what upper concentration level he surmises. Neither the specification nor the Examples show anything out side the 2-10% by weight SCCP concentration range. As far the art rejections are concerned "cosmetic composition" is directed to the intended use and such it has no patentable significance. Furthermore, mineral oil and vaseline oil are cosmetic compositions and they are petroleum oil fractions, which are part of the invention of Mueller et al. Morawsky et al. 5,736,125 in column 3, lines 19-33, show that the concentration range at which an SCCP thickens oil is from about 0.1% to about 12%. This overlaps the concentration range of 0.001 to 1% claimed by Mueller et al. This makes the argument about pour point depressants being viscosity depressants moot. All rejections are maintained by the examiner. As far as the Petition is concerned, the examiner does not handle petitions and all inquiries about petitions should be addressed to the Petition Branch.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on 7:00 a.m-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
March 30, 2003